



27 AUG 2002

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In re Application of	:	DECISION ON
DESMOTS et al.	:	
Application No.: 09/381,890	:	PETITION UNDER
PCT No.: PCT/GB98/00950	:	
Int. Filing Date: 30 March 1998	:	37 CFR 1.47(a)
Priority Date: 09 April 1997	:	
Attorney Docket No.: 08291/619001	:	
For: DIPALATORY COMPOSITIONS, THEIR	:	
PREPARATION AND USE	:	

This is a decision on applicants' "RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 08 March 2002.

#### **BACKGROUND**

On 30 March 1998, applicants filed international application PCT/GB98/00950, which claimed a priority date of 09 April 1997. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 October 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 November 1998, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 October 1999 (09 October 1999 being a Saturday and 11 October 1999 being a legal public holiday).

On 24 September 1999, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, an unexecuted declaration.

On 02 November 1999, a "Notification of Missing Requirements Under 35 USC 371" (Form PCT/DO/EO/905) was mailed to applicants requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and surcharge fee under 37 CFR 1.492(e). A one month period for reply was set therein.

On 03 April 2000, applicants filed an executed declaration, surcharge fee under 37 CFR 1.492(e), and petition/fee for a four month extension of time. The declaration identified an inventor's name not appearing in the published international application, i.e., Severine Poette, and failed to identify an inventor's name that does appear therein, i.e., Severine Hemery.

On 04 May 2000, a "Notification of Defective Response" (Form PCT/DO/EO/916) was mailed to applicants indicating that the declaration failed to identify the inventors.

On 05 June 2000, applicants filed a renewed petition indicating that Ms. Hemery's last name was changed to "Poette" as a result of marriage.

On 19 September 2000, a decision was mailed to applicants indicating that the petition under 37 CFR 1.182 regarding the name change of Ms. Hemery was granted. It was also noted, however, that the executed declaration filed 03 April 2000 failed to comply with 37 CFR 1.497(a). The decision stated that a new oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required. A one month extendable time period was set.

On 19 March 2001, applicants submitted the instant "RESPONSE TO DECISION ON PETITION". The submission was accompanied by: declarations of inventors from each of David Acher, Gerd Dahms, Bruno Guillaume, and Severine Poette; a petition under 37 CFR 1.47(a) including declarations by Amanda J. Wilde; and a petition/fee for a five month extension of time.

On 23 April 2001, applicants submitted a "REQUEST FOR REFUND" requesting that the fees in the amount of \$130.00 and \$1,760.00 charged to Deposit Account No. 06-1050 be refunded as these fees were submitted by check on 19 March 2001.

On 21 August 2001, a decision was mailed to applicants indicating that the petition under 37 CFR 1.47(a) was dismissed. Specifically, it was noted that factual proof that the missing joint inventors refuse to execute the application or cannot be reached after diligent effort had not been provided nor was an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor provided. The decision also indicated that a new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, was required.

On 08 March 2002, applicants filed the instant "RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)", which was accompanied by, *inter alia*, declarations of inventors from David Acher and Gerd Dahms, a petition under 37 CFR 1.47(a) including a number of declarations of facts; and a petition/fee for a four month extension of time.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to (1), the fee of \$130.00 has been paid.

As to (3), a statement of the last known addresses of Annick Canelas, Bruno Guillaume, Sarah Desmots, Philippe Ledon, and Severine Poette has been provided.

As to (2), the renewed petition alleges that Annick Canelas and Bruno Guillaume refuse to sign. As noted in MPEP 409.03(d)

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

It is again noted that applicants failed to show or provide proof that a copy of the application papers (specification, including claims, drawings, and oath or declaration) were presented to these non-signing inventors. The copies of the letters mailed to these non-signing joint inventors requesting that they sign a declaration of inventors suggest that only a declaration was sent to these inventors. Accordingly, item (2) is not met for inventors Annick Canelas and Bruno Guillaume. *This is the second time applicants have been informed of this defect. If a renewed petition is submitted with this same defect, the response will not be considered a bona fide response.*

The renewed petition also alleges that Sarah Desmots, Philippe Ledon, and Severine Poette cannot be found or reached after diligent effort. Copies of returned mail labels from UPS have been provided. However, it is not clear that a diligent effort has been made to reach these inventors. The only attempt to find an address for any of these inventors was to check the address listed with the Human Resources Department of Reckitt Benckiser France. It does not appear that any attempt was made to locate these inventors after the mail delivered to their addresses was returned as undeliverable. Such attempts might include but would not be limited to contacting the local post office to check for a forwarding address, checking a local phone directory, or checking an Internet directory. Accordingly, item (2) is not met for inventors Sarah Desmots, Philippe Ledon, and Severine Poette. It is also noted that applicants failed to show or provide proof that a copy of the application papers (specification, including claims, drawings, and oath or declaration) were presented to these non-signing inventors. The copies of the letters mailed to these non-signing joint inventors requesting that they sign a declaration of inventors suggest that only a declaration was sent to these inventors.

As to (4), again it is not clear that each 37 CFR 1.47(a) applicant has signed on behalf of the non-signing joint inventors since the declarations which have been executed do not list the non-signing joint inventors. Again it is noted that each executed declaration must identify all of the inventors. The declarations accompanying the petition under 37 CFR 1.47(a) filed 08 March 2002 again list only one inventor rather than all of the inventors. Consequently, a new oath(s) or

declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, is required. Applicants have not met item (4). *This is the second time applicants have been informed of the same defect. If another declaration is submitted with this defect, the response will not be considered a bona fide response.*

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

**CONCLUSION**

For the above reasons, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

A new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, is required within TWO (2) MONTHS of the mail date of this decision.

Failure to timely file the proper response will result in **ABANDONMENT** of this application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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